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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,048	02/25/2000	Robin R. Oder	ODER-8	6808

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EXAMINER

HONG, WILLIAM

ART UNIT	PAPER NUMBER
3725	

DATE MAILED: 06/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/514,048	ODER ET AL.	
	Examiner William Hong	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 May 2002.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-47 is/are pending in the application.

4a) Of the above claim(s) 19-27, 46 and 47 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-8 is/are rejected.

7) Claim(s) 7-18 and 34-45 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 25 February 2000 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-18, in Paper No. 3 is acknowledged. The traversal is on the ground(s) that the inventions are related. This argument is found persuasive for Groups I and III and accordingly, they are rejoined as one group. This is not found persuasive for the remaining groups because the remaining inventions are not related as noted in the restriction requirement of the previous Office Action. For example, Groups II, IV, and V are differing and patentably distinct methods for the reasons previously noted. These groups require different and individual considerations by the examiner. Accordingly, claims 19-27 and 46-47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim.

The requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because the abstract exceeds the 150 word limit. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because:

- 1) The terms “MagMill” and “ElectriMag” are used throughout the specification. The examiner is not familiar with these terms or the specificities of such an apparatus. These terms should be explained fully before the first instance of their use. Additionally, is this a trademark? If so, a trademark symbol should be used.
- 2) On page 24, last paragraph, the applicant’s use the term “work function”. It is not clear to the examiner what this term means and what properties does a particle have is it has a “lowest work function” or a “highest work function”.

Appropriate correction is required for the above specification objections. Additionally, the lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters 7, 8, 9, and 10 have been used to designate both a removal mechanism and a separation mechanism.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "705" and "612" have both been used to designate an air lock. Additionally,

reference characters "611" and "711" have both been used to designate a flange for the air lock.

Are these the same air lock?

The drawings are objected to because the specification on page 18, line 24 calls for a "suspended 203". It is not clear to the examiner from the description or the drawings that reference 203 is a "suspended".

A proposed drawing correction or corrected drawings are required in reply to the Office Action to avoid abandonment of the application. The objections to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Musto et al. Musto et al disclose an apparatus for separating undesirable material comprising: an air-swept roller mill (10) having a feed mechanism (12); a separation/removal mechanism (38) connected to the roller mill; an air blower (col. 7 line 67 through col. 8 line 5); a mechanism for returning material from the separation mechanism back to the pulverizer (col. 8, lines 5-10);

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Musto et al in view of Sawamura et al. Musto et al have been described above. Musto et al do not disclose the separation mechanism has a conveyor. Sawamura et al disclose the separation mechanism (52) has a conveyor (54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the separation mechanism of Musto et al with a conveyor in view of Sawamura et al as a means to transport material from the separation mechanism to the next step in the process.

***Allowable Subject Matter***

Claims 7-18 and 34-45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The art of record, considered alone or in combination, neither anticipates nor renders obvious an apparatus for separating undesirable material from desired material comprising a mechanism for diversion of material removed from the pulverizer directly to refuse without going to the separation mechanism in combination with the rest of the claimed limitations.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references listed on the attached PTO 892 are cited to show relevant comminuting and separation apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Hong whose telephone number is 703-308-9619. The examiner can normally be reached on Mon-Thu, 8:00a-6:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen Ostrager can be reached on 703-308-3136. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.



William Hong  
Examiner  
Art Unit 3725

June 5, 2002